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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

JUN 26 1996

PAT & TM OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte JEAN M. CLEMENT

Appeal No. 95-4596  
Application 08/054,951<sup>1</sup>

ON BRIEF

Before SCHAFFER, Vice Chief Administrative Patent Judge, GARRIS  
and WEIFFENBACH, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-18 and 49-52 which are all of the claims remaining in the above identified reissue application.

<sup>1</sup> Application for patent reissue filed April 27, 1993. According to appellant, the application is a continuation of Application 07/600,012, filed October 18, 1990, now abandoned, for reissue of U.S. Patent No. 4,780,179 issued October 25, 1988, issued from Application 06/822,943, filed January 27, 1986, which was a continuation of Application 06/482,623, filed April 6, 1983, now abandoned.

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The subject matter on appeal relates to a method of treating a mixture of printed and contaminated waste paper in order to produce a pulp for use in the manufacture of paper and paper boards. Appealed claims 1-18 correspond to the claims of the patent for which reissue is sought. According to the appellant, the scope of these claims is unnecessarily limited thereby rendering his patent defective under 35 USC § 251 because patentee claimed less than he had a right to claim. In an attempt to cure this perceived defect, the appellant has filed in this reissue application appealed claims 49-52 which are broader in scope than the aforementioned patent claims. These broadened claims are adequately represented by independent claim 49, a copy of which taken from the Appeal Brief is appended to this decision.

No prior art has been relied upon by the examiner in the rejections before us on this appeal.

#### THE REJECTIONS

(I) Claims 49-52 are rejected under 35 USC § 251 "as being broadened in a reissue application filed outside the two year statutory period" (Answer, page 3).

(II) Claims 1-18 and 49-52 are rejected under 35 USC § 251 "as being based upon a defective reissue declaration" (Answer, page 4).

(III) Finally, claims 1-18 and 49-52 are rejected under 35 USC § 251 "as lacking basis for reissue, since recapture is not an error correctable by reissue" (Answer, pages 5-6).

Rather than reiterate the respective positions advocated by the appellant and the examiner concerning the above noted rejections, we refer to the Brief and to the Answer for a complete exposition thereof.

#### OPINION

We will sustain rejections (II) and (III) of claims 1-18 and 49-52 which are respectively premised upon a defective reissue declaration theory and a recapture theory. However, we will not sustain rejection (I) of claims 49-52 as being broadened in a reissue application filed outside the two year statutory period. Our reasons are set forth below.

#### Rejection (I)

We agree with the appellant that the subject broadening reissue application was timely filed because its parent reissue application serial no. 07/600,012 constituted a broadening reissue application filed within the two year statutory period set forth in 35 USC § 251. Buell v. Beckestorm, 22 USPQ2d 1128, 1131-1132 (Bd. Pat. App. & Int. 1992). In support of her contrary view, the examiner argues that the parent reissue application should not be regarded as a broadening reissue application because it lacked basis for reissue under § 251 in

that the newly added claims thereof were directed to a claimed invention which had been non-elected and cancelled from the appellant's original patent application. See, for example, In re Orita, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977), In re Mead, 581 F.2d 251, 256-257, 198 USPQ 412, 417-418 (CCPA 1978) and In re Watkinson, 900 F.2d 230, 232, 14 USPQ2d 1407, 1409 (Fed. Cir. 1990). We do share the examiner's view.

We accept the examiner's uncontested assessment that the appellant's parent reissue application serial no. 07/600,012 lacked basis for reissue because it was directed to a claimed invention which had been non-elected and cancelled from the original patent application. Nevertheless, the appellant has correctly pointed out and the examiner has not disagreed that these claims of the parent reissue application were larger (i.e., broader) in scope than the original patent claims and were filed within two years from the original patent grant. These last mentioned facts clearly satisfy the literal requirements for a broadening reissue patent set forth in the last paragraph of 35 USC § 251. Nothing in § 251 excludes scope-enlarging claims from the penumbra of its last paragraph solely on the basis of the invention defined by such claims. Compliance with this paragraph depends upon whether the timely-filed reissue application claims are scope-enlarging rather than whether they are directed to an invention the same as or different from the invention claimed in

the patent. Compare In re Ruth, 278 F.2d 729, 126 USPQ 155 (CCPA 1960) (reissue application process claims held to be broader than patent apparatus claims and therefore contrary to the last paragraph of § 251).

For the reasons set forth above, it is our conclusion that the claims of the appellant's parent reissue application, even though directed to a claimed invention which had been non-elected and cancelled in the original patent application, nevertheless complied with the last paragraph of § 251 since they were timely-filed and scope-enlarging. It follows that the scope-enlarging claims 49-52 of the subject reissue application were also timely filed pursuant to this paragraph. Buell v. Beckestrom, supra. We are compelled by these circumstances to not sustain the examiner's § 251 rejection of claims 49-52 "as being broadened in a reissue application filed outside the two year statutory period."

#### Rejection (II)

The appellant argues that the rejection based upon a defective reissue declaration is improper because the declaration in question properly specifies the errors relied on and how those errors occurred. In particular, the appellant specifies that the errors constituted unduly narrow limitations in step (a) of claim 1 concerning room temperature and specific mechanical energy as well as in steps (c) and (d) of claim 1 concerning temperature,

mechanical energy and pH conditions. According to the appellant, these errors occurred during prosecution of the applications from which his patent ultimately issued and arose due to communication difficulties with his U.S. attorneys.

The above noted explanation in the reissue declaration of how the errors arose or occurred is plainly unacceptable with respect to the temperature limitation in steps (c) and (d) of patent claim 1. This limitation was present in the original claims of the appellant's first filed application and continued to be present in all prosecuted claims of the applications from which the patent under consideration ultimately issued. It is apparent, therefore, that the temperature limitation in steps (c) and (d) of patent claim 1 did not occur due to communication difficulties with the U.S. attorneys during prosecution of the patent applications as stated in the reissue declaration. Moreover, we reiterate the examiner's point, to which the appellant has not responded, that the reissue declaration does not specify the room temperature limitation in step (b) of patent claim 1 as an error (or explain how it arose) even though step (b) of newly added claim 49 defines the corresponding temperature limitation in broader terms. For these reasons, we agree with the examiner that the appellant's reissue declaration is defective under 37 CFR 1.175. In re Constant, 827 F.2d 728, 729, 3 USPQ2d 1479, 1480 (Fed. Cir. 1987). It follows that we will

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sustain the § 251 rejection of claims 1-18 and 49-52 as being based upon a defective reissue declaration.

Rejection (III)

As previously indicated, the examiner has also rejected claims 1-18 and 49-52 on the grounds that the appellant is here attempting to recapture broad subject matter surrendered during original prosecution of his patent applications. There is no dispute on this record that claims 49-52 constitute an attempt to recapture broad subject matter surrendered by amendments of original patent application claims to include temperature, mechanical energy and pH limitations in an effort to avoid prior art rejections. Instead, it is the appellant's position that the recapture rule does not apply in this case because the amendments in question cannot be regarded as an admission that the broader-scope patent application claims were not in fact patentable. According to the appellant, this is because the patent application claims were allowed by the examiner as a result of a declaration by Michael Burns rather than the previously noted amendments.

Contrary to the appellant's view, the record before us contains substantial evidence that these claim amendments were made to avoid prior art rejections, thus constituting an implicit admission that the unamended claims were not patentable over the prior art.

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First of all, we observe that all of the claims in the appellant's original patent application serial no. 06/482,623 were finally rejected under 35 USC § 103 as being unpatentable over Ortner et al. in view of Raymond et al. and Eriksson (see the Office action mailed August 28, 1985 as paper no. 8). In response to this final rejection, the appellant refiled his application as serial no. 06/822,943 along with a preliminary amendment via which all claims were limited to specific temperature and mechanical energy features (see preliminary amendment D filed January 27, 1986 as paper no. 13). This amendment included argument that Ortner and the other references applied in the parent-application final rejection would not have suggested certain independent claim features including the room temperature limitation (see step (a)) and the combination of high temperature and mechanical energy limitations (see steps (c) and (d)); e.g., see the paragraph bridging pages 17 and 18 as well as the first full paragraph on page 18 of the preliminary amendment. Significantly, the examiner responded to this claim amendment and argument by dropping the rejection based on Ortner and replacing it with a rejection based on Burns which the examiner characterized as "clearly closer prior art than the Ortner et al. patent"; see the Office action mailed September 23, 1986 as paper no. 14, especially the second full paragraph on page 4.



It is apparent to us that the appellant's successful effort to avoid the Ortner-based rejection constitutes an implicit admission that broader claims not restricted to the above noted room temperature limitation and the combined high temperature/mechanical energy limitations, such as appealed claims 49-52, were not patentable over the prior art represented by Ortner. From our perspective, the above noted preliminary amendment evinces a deliberate decision on the appellant's part to surrender more broadly claimed subject matter in a successful attempt to overcome the Ortner-based prior art.

This perception is reinforced by an acknowledgement made by the appellant in parent reissue application serial no. 07/600,012. As correctly observed by the examiner, on page 3 of the "Reply To The Examiner's Answer" filed in this parent reissue application (see paper no. 14 filed June 1, 1992), the appellant (i) stated that "[t]he Examiner further argues that Appellant added the very specific process parameters of reissue claim 1 [i.e., which corresponded to patent claim 1] during the prosecution of parent application serial no. 822,943 in order to distinguish over the prior art" and (ii) acknowledged that "[t]his is correct" (emphasis added). This acknowledgement is further evidence that the appellant deliberately surrendered more broadly claimed subject matter in order to avoid the prior art.

Finally, the record before us does not support the appellant's position that the Burn's declaration, rather than the above discussed claim limitations, resulted in allowance by the examiner of the patent claims. In the paragraph bridging pages 2 and 3 of paper no. 29 (i.e., the Notice Of Allowability and attachments mailed May 16, 1988) in patent application serial no. 06/822,943, the examiner expressly stated as a reason for allowance that the claims distinguished over Burns because that reference "does not recognize the removal of stickies prior to the dispersal unit as now claimed with room temperature pulping and cleaning" (emphasis added). The fact that the examiner considered the room temperature limitation of the patent claims to be a reason for allowance controverts the appellant's position that this limitation played no role in his successful endeavor to distinguish the patent claims over the prior art represented by Burns.

For the several reasons set forth above, we are convinced that the room temperature limitation in step (a) as well as the combined high temperature/mechanical energy limitations in steps (c) and (d) of the patent claims (i) were deliberately added to overcome the prior art rejections based upon Ortner and Burns respectively, (ii) were argued by the appellant to be features not suggested by Ortner or Burns and (iii) were accepted by the examiner as distinguishing over these

references. Since these limitations are not present in appealed claims 49-52, it is evident that these claims are an attempt by the appellant to recapture the broader subject matter which he deliberately surrendered in order to overcome prior art rejections during prosecution of his patent applications. It is well settled that the recapture rule applies when the reissue claims, as here, are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution and that error under the reissue statute does not include a deliberate decision to surrender specific subject matter in order to overcome prior art. Mentor v. Coloplast, 998 F.2d 992, 996, 27 USPQ2d 1522, 1525 (Fed. Cir. 1993). Also see Ball Corp. v. United States, 729 F.2d 1429, 221 USPQ 289 (Fed. Cir. 1984) and Patecell v. U.S., 12 USPQ2d 1440 (Ct. Cl. 1989). Because the appellant's attempt to recapture deliberately surrendered subject matter does not constitute error under the reissue statute, it is appropriate to sustain the examiner's § 251 rejection of claims 1-18 and 49-52 "as lacking basis for reissue, since recapture is not an error corrected by reissue."

SUMMARY

In conclusion, we have sustained each of the rejections advanced on this appeal except for the examiner's rejection of claims 49-52 "as being broadened in a reissue application filed outside the two year statutory period."

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The decision of the examiner is affirmed.

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

AFFIRMED

*Richard E. Schafer*  
RICHARD E. SCHAFER )  
Vice Chief )  
Administrative Patent Judge )

*Bradley R. Harris*  
BRADLEY R. GARRIS )  
Administrative Patent Judge )

*Cameron Weiffenbach*  
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BOARD OF PATENT  
APPEALS AND  
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APPENDIX

49. A method of treating a mixture of printed and contaminated waste paper in order to produce a pulp for use in the manufacture of paper and paperboards, said waste paper containing non-ink contaminants including stickies which method comprises:

- (a) forming a first aqueous fibrous suspension of said waste paper at a temperature below the melting point of the non-ink contaminants by applying specific mechanical energy sufficient to form a pumpable slurry and to release substantially all of the non-ink contaminants including the stickies from the surface of the paper without dispersing such non-ink contaminants as finely divided particles throughout the fibrous suspension;
- (b) removing substantially all of the non-ink contaminants including the stickies, which have been released without dispersal as finely divided particles from the first fibrous suspension by screening and cleaning to form a second aqueous fibrous suspension substantially free of the non-ink contaminants including the stickies;
- (c) after the step of removing the non-ink contaminants, (1) softening the ink vehicles and weakening their binding with the surface of the fibers, and then (2) detaching the ink particles from the surface of the fibers and dispersing the particles into the second fibrous suspension by submitting the second fibrous suspension at a consistency of more than 15% to the simultaneous actions of

temperature, pressure, specific energy and chemical dosing sufficient to insure softening of the ink vehicles, detachment of the ink particles from the surface of the fibers and dispersion of the detached ink particles into the second fibrous suspension, whereby higher specific energy inputs and higher temperatures are used to detach the ink particles from the fibers of the second fibrous suspension after removal of the non-ink contaminants than are used on the first fibrous suspension before removal of the non-ink contaminants;

- (d) limiting the total duration of step (c) (1) and (c) (2) to a range between 2 and 10 minutes and
- (e) removing the detached ink particles from the second fibrous suspension to provide a brightness of at least 59 ISO in the final pulp.